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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 00-004 | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 20, 2007</u> Signature _____ Typed or printed name <u>Veronika S. Leliever</u> | | Application Number <u>09/603677</u> | Filed <u>June 26, 2000</u> |
| | | First Named Inventor <u>Raymond J. Mueller</u> | |
| | | Art Unit <u>3714</u> | Examiner <u>Ronald Laneau</u> |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | | | |
| <input type="checkbox"/> | applicant/inventor. | <u>/Michael Downs 50252/</u> Signature <u>Michael D. Downs</u> Typed or printed name <u>203.461.7292</u> Telephone number <u>July 20, 2007</u> Date | |
| <input type="checkbox"/> | assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | | |
| <input checked="" type="checkbox"/> | attorney or agent of record. <u>50, 252</u> Registration number _____ | | |
| <input type="checkbox"/> | attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required, see below*. | | | |
| <input type="checkbox"/> | *Total of _____ forms are submitted. | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS**A. INTRODUCTION**

Claims 1-9, 50, 52-59, 70-74, 77, and 101 are pending and rejected under Section 103(a).

The rejections of the pending claims suffer from clear errors. Appellants have filed a Notice of Appeal and concurrently request pre-Appeal Brief review of the Section 103(a) rejections at least because

(1) Fiorini does not support the finding that it teaches *wherein said offer amount is based, at least in part, on an amount of change due (or a round-up amount)*; and

(2) the proposed motivation to modify Glickman to allow for offers based on an amount of change (or round-up amount) would add unnecessary complexity to the telemarketing, credit card- and check-based system of Glickman.

B. SECTION 103(A) REJECTION—GLICKMAN + LERNER

Claims 9, 53 and 54 stand rejected 35 U.S.C. 103(a) as being unpatentable over

Glickman ("10 Infomercial Facts you need to know", Supplement: The Infomercial Special Sourcebook Issue, *Adweek Eastern Edition*, vol. 34, No. 10, March 8, 1993, Pg. 28(5)); and

Lerner (U.S. Patent No. 5526257).

[Office Action, page 16]. Appellants traverse this ground of rejection of Claims 9, 53, and 54.

Claim 9 depends from independent Claim 1 and therefore includes the following feature: *wherein said offer amount is based, at least in part, on an amount of change due*.

Claims 53 and 54 depend from independent Claim 50 and therefore include the following feature: *wherein said offer amount is based, at least in part, on at least one of an amount of change due or a round-up amount*.

The Examiner admits that Glickman does not teach or suggest either of the features specified above. [Office Action, pages 4, 8]. Appellants submit that Lerner does not teach or suggest such features; the Examiner does not assert otherwise.

The Examiner's failure to base the grounds of rejection of Claims 9, 53, and 54 on evidence that such features were known is clear error.

The Examiner also does not rely on any evidence of the desirability of modifying the proposed combination of Glickman and Lerner in order to provide for the above features. Accordingly, the only evidence relied upon (Glickman and Lerner) cannot support a prima facie case of obviousness of Claims 9, 53, and 54. Appellants request withdrawal of the rejections and allowance of Claims 9, 53, and 54.

C. SECTION 103(A) REJECTION—GLICKMAN + FIORINI

Claims 1-8, 50, 52, 55-59 and 70-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman ("10 Infomercial Facts you need to know", Supplement: The Infomercial Special Sourcebook Issue, *Adweek Eastern Edition*, vol. 34, No. 10, March 8, 1993, Pg. 28(5)) and Fiorini ("No Place for Penny?/Smallest Count Doesn't Make Cents to Some", *USA Today*, July 29, 1994).

Each of independent Claims 1, 50, 57, and 70 generally recites a feature of *wherein said offer amount is based, at least in part, on an amount of change due (or a round-up amount)*.

Appellants submit that neither Glickman nor Fiorini teaches or suggests such features, and accordingly, no prima facie case of obviousness has been established for any of the independent Claims 1, 50, 57, and 70 (or dependent Claims 2-8, 52, 55, 56, 58, 59, 71-74).

The Examiner asserts

Fiorini discloses a bill that was before Congress to phase out the penny by rounding off cash sales and Curt Sheely, the general manager at Christie's Cafe and Bakery already rounds up or down to avoid taking pennies and one way to round it up is to offer to customers a product for the value of the change due.

[Office Action, page 4 (emphasis added)].

The Examiner's misinterpretation of Fiorini is clear error. Fiorini cannot support the Examiner's finding; Fiorini does not teach "one way to round it up is to offer to customers a product for the value of the change due." Fiorini does not even suggest additional offers, much less an offer to round up for the value of the change due. The plain language of Fiorini cannot support the Examiner's reading.

The Examiner now asserts such a teaching is somehow "inherent" in Fiorini:

the system of Fiorini would inherently include an offer of a product for the value of the change due to a customer because no customer would allow their change to be taken by a retailer.

[Office Action, page 20]. Appellants traverse the Examiner's findings that "no customer would allow their change to be taken by a retailer" and "one way to

round it up is to offer to customers a product for the value of the change due" are somehow "inherent" in Fiorini. The Examiner has not provided substantial evidence that any such teachings are inherent.

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Thus, inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art. Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

Thus, the question is whether one skilled in the art would read Fiorini as describing subject matter that would be impossible to provide for without (i) an offer to round up with a product and/or (ii) an absolute refusal of any and all customers to give up their change.

The Examiner has not established, by intrinsic, extrinsic, or any substantial evidence that one skilled in the art would read the description in Fiorini of how the general manager rounds up or down as necessarily, not probably or possibly, showing what the Examiner asserts, much less *wherein said offer amount is based, at least in part, on an amount of change due (or a round-up amount)*. Appellants cannot identify any evidence in the record to support a finding that one skilled in the art would so read Fiorini.

The Examiner has no basis for establishing that rounding up in Fiorini can only be accomplished by offering a product for change (i.e., that it is impossible for the rounding up to have taken place in any other way). It is not impossible that the general manager was simply rounding up the prices without offering additional products (as the plain language of Fiorini would suggest), and it is not impossible that customers were either accepting or refusing the rounded up price. Any speculation on the Examiner's part as to how a customer would react to rounding up does not support a finding that the general manager must necessarily have been offering a product for the value of the change.

In fact, the Examiner's own findings are contradictory. The Examiner finds that offering a product is "one way" to round up a price. [Office Action, page 4]. The Examiner thus believes that other ways are possible. That aside, there is no evidence that a manager could not simply impose a requirement on his customers that prices are to be rounded up without additional products, despite what customers may prefer.

Further, Fiorini strongly suggests that the rounding up by Curt Sheely does not include offering another product (Sheely receives complaints and is accused of "devaluing the dollar"). Were the general manager necessarily offering another product, it is unlikely that the manager would be accused of "devaluing the dollar."

Accordingly, Applicants respectfully submit that *wherein said offer amount is based, at least in part, on an amount of change due (or a round-up amount)* is not taught, inherently or explicitly, by Fiorini.

As the Examiner admits, Glickman does not teach the asserted subject matter either. Accordingly, the asserted combination of references (Fiorini and Glickman) does not teach all of the features of independent Claims 1, 50, 57, and 70.

The Examiner also has not provided substantial evidence of a motivation to modify Glickman in the manner proposed. Glickman is directed to inbound call centers infomercials, and describes payment by check or credit card. Because no physical currency trades hands in Glickman (unlike the in-person retail exchanges discussed in Fiorini) it is unlikely there would be spare change for check and credit card payments in the Glickman system. In fact, the proposed law discussed in Fiorini would not round up "sales paid by check or credit card." Accordingly, the cited references, considered together, teach away from the proposed modification.

The Examiner has not established a prima facie case, supported by substantial evidence, to modify Glickman in light of Fiorini to allow for rounding up amounts or making offers based on spare change, and, to the contrary, the cited references teach away from such a modification. Further, no combination of Glickman and Fiorini teaches all of the features of any of independent Claims 1, 50, 55, 57, and 70 (or dependent Claims 2-9, 52- 54, 56, 58, 59, and 71-74), as neither Glickman nor Fiorini teaches or suggests *wherein said offer amount is based, at least in part, on an amount of change due (or a round-up amount)*. Appellants respectfully request withdrawal of the Section 103(a) rejections and allowance of Claims 1-8, 50, 52, 55-59 and 70-74.

D. SECTION 103(A) REJECTION—GLICKMAN + FIORINI (+ WALKER)

Claims 77 and 101 are unpatentable over Glickman in view of Fiorini and in further view of Walker (U.S. Patent No. 5884272).

Each of independent Claims 77 and 101 recites a feature generally directed to *wherein said offer amount is based, at least in part, on an amount of change due*.

The Examiner relies again on Fiorini as “inherently” teaching this feature. [Office Action, page 19]. Appellants disagree with this assertion for the reasons stated above with respect to the other independent claims.

For at least these reasons, Appellants respectfully request withdrawal of the Section 103(a) rejections and allowance of Claims 77 and 101.

E. ADDITIONAL COMMENTS

Appellants’ silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner’s interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, Appellants need not address all of the Examiner’s assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.